

REMARKS

Claims 1-21 are pending in this application. Reconsideration and allowance of this application are respectfully requested.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cochran, U.S. Pat. No. 5,995,979 in view of Waugh et al. ("Waugh"), U.S. Pat. No. 6,473,898, and further in view of Applicants' admission of prior art ("APA"). This rejection is respectfully traversed.

Applicants submit that Cochran, Waugh and APA, individually or in combination, fail to disclose or suggest a system for automating an operation parameter list process, comprising, at least:

a database for storing parameter value data; and

a web-based interface for accessing the stored parameter value data and configured to automatically provide notification of modification to the stored parameter value data, wherein an analysis of an operating parameter is performed using the operation parameter list to determine appropriate operating conditions of the system

as recited in claim 1.

Cochran discloses a method for managing the presentation of search terms on a computer terminal or other display device so that a database can be searched. A search of the database is conducted based upon selected term from at least one of multiple listings. A subset of records identified by the search is then used to form new listings of search terms that are then displayed on the display device. The user may examine a new subset of search terms and either view one or all of the records located, further limit the search or reset all or part of the search (column 8, line 54 – column 9, line 23). Further, Cochran

teaches that the original search terms are fixed and cannot be modified (column 9, lines 35-36).

In regard to Waugh, the Examiner allegedly asserts that Waugh teaches providing notification of modification to the parameter valued data, and directs Applicants to Figure 2e, particularly the “add” or “remove” SKU info. However, it is submitted that the modification to the search terms of Waugh is performed by a data entry RA by exercising the option of entering additional warranty attributes by clicking the SKU info “add”, for example, rather than automatically providing the notification of modification to the parameter valued data.

In regard to APA, as fully discussed in the disclosure, APA involves the manual exchange of files (e.g., files having proposed OPL values), which results in delays and errors. In other words, the manual exchange of files provides inconsistencies and disagreements between a vendor and customers through conventional channels, whereby the extra time that may be required to complete the process the data will add cost to the overall OPL process.

Accordingly, Applicants submit that the references of Cochran, Waugh and APA are not combinable, and the Examiner has not provided any evidence of a suggestion or a motivation for combining the references. Specifically, the Examiner has failed to provide any evidence of motivation why the system of Waugh and APA would be used in the computer database of Cochran. These shortcomings of the references must be supplemented by some other teaching wherein one of ordinary skill in the art must be motivated to provide the supplemental teaching by some motivation, teaching or suggestion of the desirability to make the combination. Further, the Examiner is using impermissible hindsight reconstruction to reject the features as recited in the claims. That is, the Examiner has used the present application as a blueprint, selected a prior art computer database of Cochran as the main structural system, and then searched other prior art for the missing features without identifying or discussing any specific evidence of motivation to combine, other than providing conclusionary statements regarding the knowledge in the art, motivation and obviousness.

The Federal Circuit that the PTO and the courts “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”, In re Fine 837 F2d 1071, 5 USPQ 2D 1780 (Fed. Cir. 1988), and that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or a motivation to combine the prior art references. Applicants submit that the Examiner has failed to provide evidence of motivation for combining the teachings of Cochran, Waugh and APA.

Further, it is submitted that the alleged combination of Cochran, Waugh and APA would not be sufficient to render the claims *prima facie* obvious, specifically combining the teachings of Waugh and APA with the teachings of Cochran would at least substantially destroy the prior art and substantially the principle of operation. For example, Cochran discloses that the original search terms are fixed and cannot be modified. Accordingly, if the alleged modification and/or combination of the prior art would change the principle of operation of the prior art invention, then the teachings and the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 272 F2d 810,123 USPQ 349 (CCPA 1959). Absence of such a *prima facie* case of evidence, there would not have been any motivation to combine the references of Cochran, Waugh and APA in the manner as suggested by the Examiner.

Accordingly, for at least these reasons, claim 1 and those claims dependent thereon are allowable over the applied art. Withdrawal of the rejection is respectfully requested.

Claims 10 and 17 are also allowable for the similar reasons discussed above. Claims 11-16 and 18-21 are allowable by virtue of their dependency on either claims 10 and 17. Withdrawal of the rejection is respectfully requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of each of claims 1-21 in connection with the present application is

earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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